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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,684	12/06/2005	Teiichi Inada	1204.45675X00	1866

20457 7590 09/21/2007  
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ARLINGTON, VA 22209-3873

EXAMINER
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SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

MAIL DATE	DELIVERY MODE
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09/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/559,684

Applicant(s)

INADA ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 10, 11 and 44-49 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 7, 10, 11 and 44-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7 September 2007</u> . | 6) <input type="checkbox"/> Other: _____  |

1. The amendment filed September 12, 2007 limits the polymer component to the elected species of acrylic rubber having the glass transition temperature and weight average molecular weight ranges originally defined in cancelled claim 6 along with the affirmative presence of a filler. The preamble language of claim 1 along with new claims 44-49 are supported by the specification.

2. Newly amended claims 1-4, 7, 10, 11 and 44-49 are directed to a species that is distinct from that originally elected since the response filed October 19, 2006 on page 8, the second paragraph, lines 9-10 elects "the absence of the filler component." The newly claimed affirmative presence of the filler is directed to a distinct species from the originally elected absence thereof.

Since applicant has received an action on the merits for the originally presented species, this has been constructively elected by original presentation for prosecution on the merits. Accordingly, all of the pending claims are withdrawn from consideration as being directed to a non-elected species (37 CFR 1.142(b) and MPEP § 821.03).

If the examination of claims directed to the non-elected species of the presence of a filler is desired, the claims should be presented in a divisional application.

3. The terminal disclaimer filed September 12, 2007 does not overcome the obviousness-type double patenting rejections over application no. 11/319,068; Tomiyama et al. 7,070,670 and Inada et al. Patent No. 5,965,269 until the fee has been submitted.

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4. The 35 U.S.C. 102(b) or 103(a) rejection over Yanagiuchi et al. Patent No. 6,521,337 presented in the non-Final rejection mailed March 12, 2007 on page 7 inadvertently omitted claim 6 therefrom. The error is regretted. The glass transition temperature of from -30°C to 50°C and weight average molecular weight of from 50,000 to 1,000,000 of claim 6 now incorporated into independent claim 1 is inherent in the especially preferred acryl based adhesive of patentees (col. 3, lines 52-54) such as that shown in Example 1 (col. 8, lines 32-36) based on the breaking strength of from about 0.196 MPa to about 4.0 MPa (col. 2, lines 44-46) and breaking elongation of from about 10% to about 150% (col. 2, lines 50-51) encompassed by and overlapping the claimed parameters, respectively.

5. The 35 U.S.C. 102(a, b or e) or 103(a) rejection over Inada et al. 5,965,269; Tomiyama et al. 7,070,670; Shimada et al. 6,090,468; Yamamoto et al. 6,265,782; Tanaka et al. 6,673,441; Teichi et al. 2003/0069331, or Japanese Patent Nos. 9-298369, 9-302313, 2000-248025 or 2002-60716 remains applicable to the amended claims since the references show acrylic rubbers with glass transition temperatures and weight average molecular weights within the claimed limits. The claim language of the capability of the adhesive sheet to be laminated with dicing tape onto a wafer and capable of stealth dicing merely indicates the ultimate intended utility of the adhesive sheet and is not a critical limitation.

6. The 35 U.S.C. 102(b) or 103(a) rejection over Japanese Patent No. 2002-280494 would be withdrawn contingent upon the resolution of the claims now drawn to non-elected species since the polyamic acid film is precluded by the claimed polymer component limited to an acrylic rubber.

The reply filed on September 12, 2007 is not fully responsive to the non-Final rejection because of the amendment of the claims the non-elected species of the presence of the filler (37 CFR 1.111). Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Robert Sellers/

Robert Sellers  
Primary Examiner  
Art Unit 1712

rs 9/15/2007